

REMARKS

Claims 1-3, 6-17, 20-22, 24-26, 29-31, 39-53, 55-60, 62, 63, 65, 66, 68, and 69 were presented for examination, claims 4, 5, 7, 9, 10, 18, 19, 23, 27, 28, 29, 30, 32-38, 53, 54, 57, 58, 61-67 and 70-74 having been previously canceled. In the above amendment, Applicants now withdraw claims 44-52 herein without traverse and without prejudice to filing the same or similar claims in a divisional or continuation application. Of the remaining claims, claims 1, 55, and 68 are independent. Applicants now amend claims 1 and 68 herein. No new matter has been added.

Applicants thank the Examiner for the courtesy of an interview on August 26, 2009. During the Interview, the Examiner suggested a number of potential claim amendments. Applicants have considered the Examiner's suggestions in preparing the present Response. Accordingly, claim 1 is herein amended to clarify that sharpened edge of the non-liquid jet tissue-excision component extends "in a direction substantially perpendicular to the axial center of the nozzle." Additionally, claim 68 has been amended to include a "a non-liquid jet tissue-excision component constructed and positioned at the distal end of the instrument to excise tissue during the surgical procedure, the non-liquid jet tissue-excision component located substantially opposite the jet-receiving opening and extending outward from a location defined by an axial center of the nozzle to a periphery having a sharpened edge extending in a direction substantially perpendicular to the axial center of the nozzle."

I. Rejections under 35 U.S.C. §103(a)

Claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31, 39-43, 55, 56, 59, 60, 68 and 69 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 5,496,267 to Drasler et al. (hereafter "Drasler") in view of U.S. Patent No. 5,318,518 to Plechinger et al. (hereinafter "Plechinger"). Claims 1, 55 and 68 remain independent. Applicants respectfully traverse the rejection.

A. Claims 1-3, 6, 8, 11-17, 20, 21, 22, 24, 25, 26, 31, 39-42 and 43

As related to claims 1-3, 6, 8, 11-17, 20, 21, 22, 24, 25, 26, 31, 39-42 and 43, the Examiner relies on Fig. 3a of Drasler for the assertion that Drasler discloses all the elements of claim 1 except a non-liquid jet tissue-excision component. The Examiner attempts to cure this deficiency by relying on the disclosure of Plechinger. Specifically, the Examiner relies on Fig. 7 of Plechinger for the disclosure of a non-liquid jet tissue-excision component on the distal end of the nozzle. Accordingly, the Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify Drasler such that the distal end of the nozzle comprised a non-liquid jet tissue-excision component with a sharpened edge.

As to independent claim 1 and its dependent claims, Applicants respectfully disagree with the Examiner's assertions and submit that at least in view of the current amendments, the combination of Drasler and Plechinger fails to establish a *prima facie* case of obviousness. Claim 1 includes a non-liquid jet tissue-excision component that is located substantially opposite the jet-receiving opening and extending "radially outward from a location defined by an axial center of the nozzle to a radial periphery having sharpened edges that are directed perpendicularly to the axial center of the nozzle." By contrast, neither Drasler nor Plechinger, independently or in combination, provides for a non-liquid jet tissue-excision component that has sharpened edges perpendicular to the liquid jet. Quite to the contrary, the cutting edge **50** of Plechinger is directed parallel to the axial center of the nozzle **14**. See Fig. 7 of Plechinger. For at least these reasons, Drasler and Plechinger fail to establish a *prima facie* case of obviousness as to claim 1.

Applicants respectfully submit that the structure, function and operation of the devices of Plechinger and Drasler are directed exclusively to insertions into tubular tissues such as veins, fallopian tubes and urethras. As noted in the amended claim and in the arguments above, the non-liquid jet tissue-excision component of the present invention is perpendicular to the axial center of the nozzle and therefore perpendicular to the direction of insertion. It is therefore exposed and any communication of the device into a vein, fallopian tube or urethra would pose an unacceptable risk of unintended lacerations. Accordingly, the orientation of the non-liquid jet tissue-excision component of the present invention would not be suitable for such use.

In view of the above arguments and amendments, Applicants submit that the invention of independent claims 1 and its respective dependent claims, are nonobvious over Drasler and/or

Plechinger. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-3, 6, 8, 11-17, 20-22, 24-26, 31 and 39-43.

B. Claims 55, 56, 59 and 60

Applicants incorporate and reiterate the above arguments herein. As related to claims 55, 56, 59 and 60, the Examiner relies on Fig. 3a of Drasler for the assertion that Drasler discloses all the elements of claim 55 except a non-liquid jet tissue-excision component.

Applicants respectfully submit that neither Drasler nor Plechinger, individually or in combination, teaches or suggests each element of claim 55. Claim 55 includes, among other elements, a non-liquid jet tissue-excision component...comprising “a cup-shaped tissue receptacle having a sharpened peripheral rim located at the distal end of the instrument.” As noted by the Examiner, Drasler does not disclose a non-liquid jet tissue-excision component. More specifically, Drasler fails to teach or suggest a non-liquid jet tissue-excision component having a cup-shaped tissue receptacle. Plechinger likewise fails to disclose this component. In Plechinger, the non-liquid jet tissue-excision component, which the examiner identifies as “cutting edge 50,” does not comprise a cup-shaped tissue receptacle having a sharpened peripheral rim located at the distal end of the instrument. Element 50 is not a cup-shaped tissue receptacle. Accordingly, Drasler in view of Plechinger fails to establish a prima facie case of obviousness as related to claim 55 and its dependent claims.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 55 and its dependent claims 56, 59 and 60.

C. Claims 68 and 69

As related to claims 68 and 69, the Examiner relies on Fig. 3a of Drasler for the assertion that Drasler discloses all the elements of claims 68 and 69 except a non-liquid jet tissue-excision component.

Applicants respectfully disagree with the Examiner's assertions and submit that at least in view of the current amendments, the combination of Drasler and Plechinger fails to establish a prima facie case of obviousness. Claim 68 includes a non-liquid jet tissue-excision component that is located substantially opposite the jet-receiving opening and extending “radially outward from a location defined by an axial center of the nozzle to a radial periphery having sharpened edges that are directed perpendicularly to the axial center of the nozzle.” By contrast, neither

Drasler nor Plechinger, independently or in combination, provides for a non-liquid jet tissue-excision component that has sharpened edges perpendicular to the liquid jet. Quite to the contrary, the cutting edge 50 of Plechinger is directed parallel to the axial center of the nozzle 14. See Fig. 7 of Plechinger. For at least these reasons, Drasler and Plechinger fail to establish a prima facie case of obviousness as to claim 68.

Applicants respectfully submit that the structure, function and operation of the devices of Plechinger and Drasler are directed exclusively to insertions into tubular tissues such as veins, fallopian tubes and urethras. As noted in the amended claim and in the arguments above, the non-liquid jet tissue-excision component of the present invention is perpendicular to the axial center of the nozzle and therefore perpendicular to the direction of insertion. It is therefore exposed and any communication of the device into a vein, fallopian tube or urethra would pose an unacceptable risk of unintended lacerations. Accordingly, the orientation of the non-liquid jet tissue-excision component of the present invention would not be suitable for such use.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of independent claim 68 and its dependent 69.

C. MPEP 2143.01 (III) and (IV)

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. See MPEP 2143.01 (III). Furthermore, MPEP 2143.01 (IV) provides that in order to establish obviousness *there must be some objective reason why one would combine the references*. It is recited at pages 3-4 of the Office Action that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Drasler et al. such that the distal end of the nozzle (124), which is substantially opposite the jet-receiving opening (distal end of 128), comprised a non-liquid jet tissue-excision component with a sharpened edge that extends radially outward from an axial center of the nozzle to a radial periphery in view of Plechinger et al.” Applicants respectfully submit that this reason is conclusory and points to MPEP 2143.01(IV) which provides that “Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Applicants respectfully submit that an objective reason for combining Drasler and Plechinger has not been provided.

CONCLUSION

In view of the above amendment, Applicants believe that the pending application is in condition for allowance. If the Examiner feels that there are any remaining issues, the Examiner is urged to call the Applicants' attorney at the phone number listed below.

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Respectfully submitted,

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